

ESTTA Tracking number: **ESTTA496464**Filing date: **09/25/2012**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	TracFone Wireless, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	9700 NW 112 Avenue Miami, FL 33178 UNITED STATES		

Attorney information	Candice Kim Greenberg Traurig, LLP 1840 Century Park East, Suite 1900 Los Angeles, CA 90067 UNITED STATES latm2@gtlaw.com, dcipmail@gtlaw.com, wadykas@gtlaw.com Phone:(310) 586-7700
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Registration Subject to Cancellation

Registration No	3288448	Registration date	09/04/2007
International Registration No.	NONE	International Registration Date	NONE
Registrant	fitage GmbH Zur Waldau 15 68239 Mannheim GERMANY		

Goods/Services Subject to Cancellation

Class 009. All goods and services in the class are cancelled, namely: Telephones and mobile phones

Grounds for Cancellation

Abandonment	Trademark Act section 14
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Attachments	petition.pdf (20 pages)(181981 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/cek/
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Name	Candice Kim
Date	09/25/2012

In the Matter of Registration No. 3,288,448
For the mark: BIG EASY
Registered September 4, 2007

Cancellation No.:

MIA 182,726,009v2 9-25-12

3. On September 18, 2012, the PTO issued an Office Action against Petitioner's Application refusing registration based upon a likelihood of confusion with Respondent's Registration. Attached as Exhibit B is a copy of the Office Action.

4. On information and belief, Respondent went out of business on or around September 20, 2010, and no longer exists.

5. On information and belief, Respondent's Registration was not assigned prior to Respondent's going out of business, Respondent is not using and has not used Respondent's Mark in commerce since at least as early as September 20, 2010, and has discontinued use of Respondent's Mark without an intent to resume such use. Accordingly, Respondent's mark BIG EASY has been abandoned.

6. For the reasons set forth herein, Petitioner believes and asserts that the continued registration of Respondent's BIG EASY mark for the goods identified therein has caused and will continue to cause damage to Petitioner.

WHEREFORE, Petitioner prays that U.S. Registration No. 3,288,448 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Respectfully submitted,

Dated: September 25, 2012

By: 

Steven J. Wadyka, Jr.
Candice E. Kim
GREENBERG TRAURIG, LLP
1840 Century Park East, Suite 1900
Los Angeles, California 90067
Tel: (310) 586-3867
Fax: (310) 586-0567
latm2@gtlaw.com
dcipmail@gtlaw.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing PETITION FOR CANCELLATION upon Respondent by depositing one copy thereof to Federal Express, postage prepaid, on September 25, 2012, addressed as follows:

Fitage GmbH
Zur Waldau 15
68239 Mannheim
Federal Republic of Germany



Exhibit A

Trademark/Service Mark Application, Principal Register

Serial Number: 85651098

Filing Date: 06/13/2012

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85651098
MARK INFORMATION	
*MARK	THE BIG EASY
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	THE BIG EASY
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	TracFone Wireless, Inc.
*STREET	9700 NW 112 Avenue
*CITY	Miami
*STATE (Required for U.S. applicants)	Florida
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	33178
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Delaware
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	009
	Electronic communications equipment,

*IDENTIFICATION	namely, cellular telephones and prepaid air time cellular telephones.
FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Manuel Valcarcel, Esq.
ATTORNEY DOCKET NUMBER	027207.031900
FIRM NAME	Greenberg Traurig, P.A.
STREET	333 Avenue of the Americas, Suite 4400
CITY	Miami
STATE	Florida
COUNTRY	United States
ZIP/POSTAL CODE	33131
PHONE	3055790812
FAX	3059615812
EMAIL ADDRESS	ipmiami@gtlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
NAME	Manuel Valcarcel, Esq.
FIRM NAME	Greenberg Traurig, P.A.
STREET	333 Avenue of the Americas, Suite 4400
CITY	Miami
STATE	Florida
COUNTRY	United States
ZIP/POSTAL CODE	33131
PHONE	3055790812
FAX	3059615812
EMAIL ADDRESS	ipmiami@gtlaw.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325

*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
SIGNATURE	/koh/
SIGNATORY'S NAME	Kenneth H. Oh, Esq.
SIGNATORY'S POSITION	Corporate Counsel-Intellectual Property
DATE SIGNED	06/13/2012

Trademark/Service Mark Application, Principal Register

Serial Number: 85651098

Filing Date: 06/13/2012

To the Commissioner for Trademarks:

MARK: THE BIG EASY (Standard Characters, see [mark](#))

The literal element of the mark consists of THE BIG EASY.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, TracFone Wireless, Inc., a corporation of Delaware, having an address of

9700 NW 112 Avenue

Miami, Florida 33178

United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Electronic communications equipment, namely, cellular telephones and prepaid air time cellular telephones.

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Manuel Valcarcel, Esq. of Greenberg Traurig, P.A.

333 Avenue of the Americas, Suite 4400

Miami, Florida 33131

United States

The attorney docket/reference number is 027207.031900.

The applicant's current Correspondence Information:

Manuel Valcarcel, Esq.

Greenberg Traurig, P.A.

333 Avenue of the Americas, Suite 4400

Miami, Florida 33131

3055790812(phone)

3059615812(fax)

ipmiami@gtlaw.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /koh/ Date Signed: 06/13/2012

Signatory's Name: Kenneth H. Oh, Esq.

Signatory's Position: Corporate Counsel-Intellectual Property

RAM Sale Number: 16907

RAM Accounting Date: 06/14/2012

Serial Number: 85651098

Internet Transmission Date: Wed Jun 13 18:00:08 EDT 2012

TEAS Stamp: USPTO/BAS-72.37.249.44-20120613180008562

772-85651098-490e4f923fa64b63c9b51afea8b

fb7f91-DA-16907-20120613170000364004

THE BIG EASY

Generated on: This page was generated by TSDR on 2012-09-24 18:25:08 EST

Mark: THE BIG EASY

THE BIG EASY

US Serial Number: 85651098

Application Filing Date: Jun. 13, 2012

Register: Principal

Mark Type: Trademark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Sep. 18, 2012

Mark Information

Mark Literal Elements: THE BIG EASY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Electronic communications equipment, namely, cellular telephones and prepaid air time cellular telephones

International Class: 009 - Primary Class

U.S Class: 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(b)

Basis Information (Case Level)

Filed Use:	No	Currently Use:	No	Amended Use:	No
Filed ITU:	Yes	Currently ITU:	Yes	Amended ITU:	No
Filed 44D:	No	Currently 44D:	No	Amended 44D:	No
Filed 44E:	No	Currently 44E:	No	Amended 44E:	No
Filed 66A:	No	Currently 66A:	No		
Filed No Basis:	No	Currently No Basis:	No		

Current Owner(s) Information

Owner Name: TracFone Wireless, Inc.
9700 NW 112 Avenue
Owner Address: Miami, FLORIDA 33178
UNITED STATES

Legal Entity Type:	CORPORATION	State or Country Where Organized:	DELAWARE
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Attorney/Correspondence Information

Attorney of Record

Attorney Name: Manuel Valcarcel, Esq. **Docket Number:** 027207.03190

Correspondent

Correspondent Name/Address: MANUEL VALCARCEL, ESQ.
GREENBERG TRAURIG, P.A.
333 AVENUE OF THE AMERICAS STE 4400
MIAMI, FLORIDA 33131-2184
UNITED STATES

Phone: 3055790812

Fax: 3059615812

Correspondent e-mail: ipmiami@gtlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 18, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 18, 2012	NON-FINAL ACTION E-MAILED	6325
Sep. 18, 2012	NON-FINAL ACTION WRITTEN	76151
Sep. 18, 2012	ASSIGNED TO EXAMINER	76151
Jun. 21, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 16, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: WILLIS, PAMELA Y

**Law Office
Assigned:**

LAW OFFICE 106

File Location

Current Location: TMEG LAW OFFICE 106 -
EXAMINING ATTORNEY
ASSIGNED

Date in Location: Sep. 18, 2012

Exhibit B

To: TracFone Wireless, Inc. (ipmiami@gtlaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85651098 - THE BIG EASY - 027207.03190
Sent: 9/18/2012 4:54:34 PM
Sent As: ECOM106@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85651098

MARK: THE BIG EASY

85651098

CORRESPONDENT ADDRESS:

MANUEL VALCARCEL, ESQ.
GREENBERG TRAURIG, P.A.
333 AVENUE OF THE AMERICAS STE 4400
MIAMI, FL 33131-2184

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jspx

APPLICANT: TracFone Wireless, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :
027207.03190

CORRESPONDENT E-MAIL ADDRESS:
ipmiami@gtlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 9/18/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Refusal to Register: Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3288448. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Facts

The applicant has applied to register the mark THE BIG EASY for “Electronic communications equipment, namely, cellular telephones and prepaid air time cellular telephones,” in International Class 9. The registered mark is BIG EASY for “telephones and mobile phones,” in International Class 9.

Comparison of Marks

Applicant's mark and the registered mark are similar in sound, appearance, and commercial impression. Both marks include the terms “big” and “easy” which are spelled the same and presented in the same sequence in each instance. As such, the marks look essentially the same, and produce nearly the same sound when spoken aloud. The commercial impression created by the marks is similar in that the shared phrase BIG EASY appears to be suggestive of a feature of the goods that the respective marks identify. Consumers would experience confusion when speaking about or observing the marks based upon the similarities detailed above.

Similarities of Goods

In addition to possessing nearly identical marks, applicant and registrant use their marks to identify similar goods. Cellular telephones (applicant's goods) and mobile telephones (registrant's goods) are basically the same type of goods. Both goods are used to communicate with people, and are portable. As such, consumers would encounter them in the same trade channels, and upon seeing or hearing nearly identical marks identifying those goods, consumers would experience confusion as to the source.

The overriding concern is not only to prevent buyer confusion as to the source of the goods, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP

§1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

The similarities of the marks and the goods are so great as to cause a likelihood of confusion among consumers. Therefore, registration is refused based upon Trademark Act Section 2(d).

Although applicant's mark has been refused registration, applicant may respond to the refusal by submitting evidence and arguments in support of registration.

Response Guidelines

There is no required format or form for responding to an Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the title "Response to Office Action" and the following information: (1) the name and law office number of the examining attorney, (2) the serial number and filing date of the application, (3) the mailing date of this Office action, (4) applicant's name, address, telephone number and e-mail address (if applicable), and (5) the mark. 37 C.F.R. §2.194(b)(1); TMEP §302.03(a).

The response must be personally signed or the electronic signature manually entered by applicant or someone with legal authority to bind applicant (i.e., a corporate officer of a corporate applicant, the equivalent of an officer for unincorporated organizations or limited liability company applicants, a general partner of a partnership applicant, each applicant for applications with multiple individual applicants). TMEP §§605.02, 712.

/Pamela Y. Willis/
Pamela Y. Willis
Trademark Examining Attorney
Law Office 106
571-272-9335
pam.willis1@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Sep 18, 2012

79034292

DESIGN MARK

Serial Number

79034292

Status

REGISTERED

Word Mark

BIG EASY

Standard Character Mark

Yes

Registration Number

3288448

Date Registered

2007/09/04

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

fitage GmbH LIMITED LIABILITY COMPANY FED REP GERMANY Zur Waldau 15
68239 Mannheim FED REP GERMANY

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Telephones and mobile phones.

Priority Date

2006/06/16

Filing Date

2006/11/27

Examining Attorney

GOLD, BARBARA

BIG EASY